

**REMARKS**

I. Introduction

The Office Action of November 1, 2006 has been reviewed and the Examiner's comments carefully considered. Claims 39-76 are pending in this application, and claims 39, 62 and 76 are in independent form. Claims 39, 45-47, 50, 52, 55, 57-62, 65-68, 71, and 73-76 have been amended. No new matter has been added.

II. Rejections under 35 U.S.C. §112

In the present Office Action, the Examiner rejects claims 39-76 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

At the outset, Applicant would like to bring to the attention of the Examiner that the PTO has the initial burden of presenting evidence and/or reasons as to why persons skilled in the art would not recognize a description of the invention as defined by the claims from the original disclosure. See In re Salem, 193 USPQ 513 (CCPA 1977). Applicant therefore requests clarification of the rejected subject matter under 35 U.S.C. §112, first paragraph, particularly in light of the support for such claim amendments, as discussed in detail hereinafter.

In particular, the Examiner asserts that the limitation "based upon said verified nutritional values" in independent claims 39, 62 and 76 was not supported by the original disclosure. However, Applicant respectfully asserts that at a minimum the following adequately supports such a limitation: "the food item database 16a preferably contains nutritional data on each food item used in a recipe contained within the recipe database[, which] preferably contains recipes that food service professionals can use, modify or add to

[and where preferably] the nutritional value and readings of all completed recipes are verified." See p. 9, lines 13-15; and p. 10, lines 1-4. Reconsideration and withdrawal of this rejection is respectfully requested.

Further, the Examiner believes that the limitation "based upon said assigned food attributes" in independent claims 39, 62 and 76 was not supported by the original disclosure. However, Applicant respectfully asserts that at a minimum the following adequately supports such a limitation: "[v]arious food attributes of meals and menus have preferably been assigned as part of the initialization of menu database 16d, and these attributes are preferably used in the menu selection". See p. 11, lines 16-18. Reconsideration and withdrawal of this rejection is respectfully requested.

The Examiner also asserts that the limitation "providing a remote link to food service professionals associated with said healthcare facility to access said system" in independent claims 39, 62 and 76 was not supported by the original disclosure. However, Applicant respectfully asserts that at a minimum the following adequately supports such a limitation: "a central server 10 is linked up to at least one remote computer 20 located in a health care facility [...] [wherein the] link 1 between the central server 10 and the remote computer 20 does not have to be a physical link--it can, for example, be a link via a global computer network as described below, or any other link, including a virtual private network [and wherein the] [r]ecipe database 16b [of central server 10] preferably contains recipes that food service professionals can use, modify or add to." See p. 6, lines 3-4, 6-9; p. 10, lines 1-2; and FIG. 2. Reconsideration and withdrawal of this rejection is respectfully requested.

Further, the Examiner believes that the limitation "collecting information from said [registered] food service professionals" in independent claims 39, 62 and 76 was not supported by the original disclosure. However, Applicant respectfully asserts that at a minimum the following adequately supports such a limitation: "[r]ecipe database 16b

preferably contains recipes that food service professionals can use, modify or add to." See p. 10, lines 1-2. Reconsideration and withdrawal of this rejection are respectfully requested.

Also, the Examiner asserts that the limitation "suggesting menu sets to said [registered] food service professionals [based upon therapeutic diet types selected by said registered food service professionals]" in independent claims 39, 62 and 76 was not supported by the original disclosure. Applicant has herein removed the bracketed portions of these claims, and thus the rejection relating to those portions is moot. Applicant does not admit that such subject matter is new matter by its removal, but rather shows Applicant's interest in expediting prosecution. Applicant respectfully asserts that at a minimum the following adequately supports the remaining limitations: "output said at least one suggested menu to at least one authorized user located remotely from said memory device [wherein the] [r]ecipe database 16b preferably contains recipes that food service professionals can use, modify or add to." See p. 4, lines 5-7; and p. 10, lines 1-2. Reconsideration and withdrawal of this rejection are respectfully requested.

Lastly, the Examiner believes that the limitation "making nutritional information associated with said menu sets available to said [registered] food service professionals" in independent claims 39, 62 and 76 was not supported by the original disclosure. Applicant respectfully asserts that at a minimum the following adequately supports the remaining limitations: "make available to the at least one authorized user the nutritional information associated with said at least one suggested menu [wherein the] [r]ecipe database 16b preferably contains recipes that food service professionals can use, modify or add to." See p. 4, lines 7-8; and p. 10, lines 1-2. Reconsideration and withdrawal of this rejection are respectfully requested.

Further, Applicant respectfully points out to the Examiner that "[m]ere rephrasing of a passage does not constitute new matter [...] where the same meaning remains

intact." See MPEP §2163.07(I). Accordingly, for at least this additional reason, reconsideration and withdrawal of the above rejections are respectfully requested.

The Examiner has also rejected claims 40-61, and 63-75 because they ultimately depend upon independent claims 39 and 62. Applicant requests clarification at a minimum as to why these claims are rejected as no statutory or legal basis has been provided for the requested cancellation of claims. In the event the Examiner intended a new matter rejection and such issues were not resolved adequately above, Applicant notes that the PTO has the initial burden of presenting evidence and/or reasons as to why persons skilled in the art would not recognize a description of the invention as defined by the claims from the original disclosure. See In re Salem, 193 USPQ 513 (CCPA 1977).

The Examiner also rejects claims 39, 45-47, 50, 52, 55, 57-62, 65-68, 71, and 73-76 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has herein amended claims 39, 45-47, 50, 52, 55, 57-62, 65-68, 71, and 73-76 to remove the language "registered" for clarity purposes. This rejection is now moot. Reconsideration and withdrawal of this rejection are respectfully requested.

### III. Tests for Obviousness

"The Supreme Court has frequently warned against the use of 'hindsight' in determining obviousness. ... It is impermissible to use the inventor's disclosure as a 'road map' for selecting and combining prior art disclosures." Chisum on Patents, §5.03[2][c], p. 5-105 - 5-109 (Rel. 90-11/03). See, e.g., Crown Operations Int'l, Ltd. v. Solutia, Inc., 289 F.3d 1367, 1376 (Fed. Cir. 2002). Further, the Examiner cannot use the claims as a blueprint for locating separate claim elements in separate prior art references without considering the teachings of the prior art as a whole and without considering the complete teachings of the separate references. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); See also In re

Wesslau, 353 F.2d 238, 241 (CCPA 1965)(“it is impermissible...to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.”) In particular, “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Still further, as set forth in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art.

In the absence of some “clear and particular” motivation to combine the teachings of the cited prior art, the rejection is improper. Winner Int’l Royalty Corp. v Wang, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000). “Numerous decisions emphasize that such a combination of reference teachings is improper unless the prior art suggests such a combination.” Chisum, § 5.04[1][d], p. 5-278. See, e.g., In re Bond, 910 F.2d 831 (Fed. Cir. 1990); Ecolchem, Inc. v. Southern Calif. Edison Co., 227 F.3d 1361, 1371 (Fed. Cir. 2000)(“Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.”)

When determining the level of ordinary skill in the art, the inventor’s actual knowledge and skill is not determinative, instead the focus should be on the skill of a hypothetical person of ordinary skill aware of the prior art teachings. Chisum, § 5.03[4][e][i], p. 5-228; Ex Parte Anderson, 21 USPQ2d 1241, 1256 (Bd. Pat. App & Int’f 1991).

The statutory emphasis is on a person of *ordinary* skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something - call it what you will - which set them apart from the workers of *ordinary* skill, and one should not go about determining obviousness under § 103 by inquiring into what *patentees* (i.e., inventors) would have known or would likely have done, faced with the revelations of the references. A person of ordinary skill in the art is also

presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.

Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454 (Fed. Cir. 1985).

#### IV. Rejections under 35 U.S.C. §103

Claims 39-40, and 44-76 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,370,513 to Kolawa et al. (hereinafter the “Kolawa patent”) in view of U.S. Patent No. 6,290,646 to Cosentino et al. (hereinafter the “Cosentino patent”).

Applicant agrees with the Examiner that the Kolawa patent does not teach or suggest making nutritional information associated with menu sets available to food service professionals. Applicant also agrees that the Kolawa patent does not teach or suggest providing a remote link to food service professionals associated with the healthcare facility to access the system. In addition, Applicant agrees that Kolawa does not teach or suggest collecting information from food service professionals.

The Examiner states that these features are “well-known in the art.” Applicant respectfully disagrees that these features are “well-known” and useable to modify the Kolawa patent as asserted in the Office Action. Further, in order to avoid such “well-known” statements as becoming admitted prior art due to a lack of traversal, Applicant herein traverses these assertions because these “well-known” assertions have not been adequately shown or referred to in the Cosentino patent, or any other prior art of record. Further, Applicant asserts that the Examiner uses improper hindsight in conjuring up a motivation wherein such motivation is misplaced, as the present invention, as claimed, does not require “monitoring” nor does it require “transmitting”.

Further, the Examiner likens a “nutritionist” to a “food service professional” even though the present invention distinguishes these roles in the specification at page 13,

lines 17-18 and page 14, line 1, which should be patently evident. Further, such logic would require, for example, "metallurgist" to read upon "automobile mechanic." Accordingly, Applicant traverses the Examiner's assertion that a "nutritionist" is the same as a "food service professional" in the rejected claims.

Still further, it appears that the Examiner is simply using the Applicant's own disclosure as a roadmap for picking and choosing various pieces and parts of the prior art to formulate the obviousness rejections. In addition, it appears that the Examiner is using the claims of the present application as a blueprint for locating separate claim elements in separate prior art references, without considering the teachings of the prior art as a whole and without considering the complete teachings of the separate references. As discussed above (and, in additional detail below), it further appears that the Examiner is improperly combining prior art references, misapplying these references and reading meanings into the terms of the claims of the present application that are not contemplated or disclosed in the present application.

Concerning claims 40, and 44-49, Applicant respectfully asserts that for at least those reasons presented above, the present invention is not obvious for these claims either, as they ultimately depend from independent claim 39 which is not rendered obvious. Further, the Examiner likens "ethnicity" to be a form of "religious beliefs". Such logic and broad reading of the claims is not meaningful and misplaced. Accordingly, Applicant traverses Examiner's assertion that "ethnicity" reads on "religious beliefs" in the rejected claims. Ultimately, if such assertions are maintained then specific language is not meaningful in defining one's invention.

Concerning claims 50-58, Applicant respectfully asserts that for at least those reasons presented above, the present invention is not obvious for these claims either as they ultimately depend from independent claim 39, which is not rendered obvious. Further, the Examiner asserts that "medical professional caregiver" reads on "food service professionals".

Such logic would require, for example, "doctor" to read upon "waitress". Accordingly, Applicant traverses Examiner's assertion that "medical professional caregiver" reads on "food service professionals" in the rejected claims.

Concerning claims 59-61, Applicant respectfully asserts that for at least those reasons presented above, the present invention is not obvious for these claims either, as they ultimately depend from independent claim 39, which is not rendered obvious. Further, for at least those reasons presented above for independent claim 39, independent claims 62 and 76 are also not rendered obvious including claims 63-75 which ultimately depend from independent claim 62.

Claim 41 is rejected under 35 U.S.C. §103(a) as being unpatentable over the Kolawa patent, in view of the Cosentino patent, and further in view of the article: "An artificial intelligence system for computer-assisted menu planning" by Petot et al. (hereinafter the "Petot article"). Applicant agrees the Kolawa patent and the Cosentino patent do not disclose "the step of eliminating variances in said therapeutic diet types among differing health care facilities." Further, Applicant respectfully asserts that the remaining shortcomings of the Kolawa patent and Cosentino patent are not overcome by the Petot article, for at least those reasons set forth above.

The Examiner states that features of claim 41 are "well-known in the art." Applicant respectfully disagrees that these features are "well-known" to modify the Kolawa patent and the Cosentino patent as asserted in the Office Action. Further, in order to avoid such "well-known" statements as becoming admitted prior art due to a lack of traversal, Applicant herein traverses these assertions because these "well-known" assertions have not been adequately shown in the Petot article, or any other prior art of record. Further, Applicant asserts that the Examiner is using improper hindsight in conjuring up a motivation, and using the claims as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.



Claims 42-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Kolawa patent, in view of the Cosentino patent, and further in view of U.S. Patent No. 6,168,563 to Brown. Applicant agrees the Kolawa patent and the Cosentino patent do not disclose "the step of evaluating diabetic exchange rates of each food item; wherein said verification of nutritional value of each of said plurality of recipes is based upon said evaluation of diabetic exchange rates of each food item." Further, Applicant respectfully asserts that the remaining shortcomings of the Kolawa patent and Cosentino patent are not overcome by the Brown patent, for at least the reasons discussed above.

Further, the Examiner states that features of claims 42-43 are "well-known in the art." Applicant respectfully disagrees that these features are "well-known" to modify the Kolawa patent and the Cosentino patent as asserted in the Office Action. Further, in order to avoid such "well-known" statements as becoming admitted prior art due to a lack of traversal, Applicant herein traverses these assertions because these "well-known" assertions have not been adequately shown in the Brown patent or any other prior art of record. Applicant asserts that these actions constitute improper hindsight reconstruction.

V. Summary

For the foregoing reasons, independent claims 39, 62 and 76 are not rendered obvious over the Kolawa patent, the Cosentino patent, the Brown patent, the Petot article, or any of the prior art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claims 39, 62 and 76 is respectfully requested.

Claims 40-61 depend either directly or indirectly from and add further limitations to independent claim 39, and claims 63-75 depend either directly or indirectly from and add further limitations to independent claim 62, all of which are believed to be


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allowable for the reasons discussed hereinabove in connection with independent claims 39 and 62, respectively. Therefore, for all the above reasons, reconsideration of the rejections of claims 40-61 and 63-75 is also respectfully requested.

For all the foregoing reasons, Applicant believes that claims 39-76 are patentable over the cited prior art and in condition for allowance. Reconsideration of the rejections and allowance of all pending claims 39-76 are respectfully requested.

Respectfully Submitted

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